

REMARKS

Initially, the Applicants would like to thank Examiner Siddiqi for the courtesies extended in conducting the in-person interview on May 11, 2011. The amendments and remarks presented herein are consistent with the discussion of the interview.

The Non-Final Office Action mailed March 17, 2011, considered and rejected claims 17–25 and 29. Claim 29 was rejected under 35 U.S.C. § 101 as being unpatentable because computer-readable medium appears in the preamble. Claims 17–25 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickson et al., U.S. Patent No. 6,226,641 (filed Feb. 17, 1998) (hereinafter Hickson) in view of Klein et al., U.S. Patent Publ. No. 2003/0212818 (filed May 8, 2002) (hereinafter Klein).¹

By this response, claims 17, 22, and 29 are amended.² Claims 17–25 and 29 remain pending. Claims 17, 22, and 29 are independent claims which remain at issue. Support for the amendments may be found, *inter alia*, within Specification pp. 15–16 and 19–20.³

Rejections Under 35 U.S.C. § 101:

Claim 29 was rejected under 35 U.S.C. § 101 “because computer-readable medium appears in the preamble” and that “[t]he broadest reasonable interpretation of . . . a computer readable medium . . . covers . . . transitory propagating signals *per se*.”⁴ Claim 29 has now been amended and the applicants submit that claim 29 is directed toward statutory subject matter under 35 U.S.C. § 101.

In particular, claim 29 has now been amended to recite a “computer readable *storage device*.”⁵ A storage device, as interpreted in view of Specification p. 19 line 26 to p. 20 line 5,

¹ Office Communication p. 2 *et seq.* (paper no. 20110312, Mar. 17, 2011). Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

² The amendments and remarks presented herein are consistent with the discussion of the interview of May 11, 2011, with Examiner Siddiqi and patent attorney Thomas M. Bonacci (reg. no. 63,368).

³ It should also be noted that the claims as recited take support from the entire Specification. As such, no particular part of the Specification should be considered separately from the entirety of the Specification.

⁴ Office Comm. pp. 2–3.

⁵ As discussed in the interview, a “computer readable storage device” is an article of manufacture and does not embrace “transitory” subject matter or propagating signals, and is thus statutory. 35 U.S.C. § 101.

The amendment notwithstanding, applicant reserves the right to further challenge this ground of rejection by way of presenting corresponding claims which define the computer readable medium in terms consistent with the breadth of that term as provided in applicant’s specification in any related application, as deemed appropriate by applicant. There are sound policy reasons why a propagating signal or carrier wave used to provide software to

explicitly limits the claim to a tangible article of manufacture and is therefore statutory under 35 U.S.C. § 101. Accordingly, the Applicants respectfully request the rejection of claim 29 under 35 U.S.C. § 101 as covering non-statutory subject matter now be withdrawn.

Rejections Under 35 U.S.C. § 103:

Claims 17–25 and 29, of which claims 17, 22, and 29 are independent claims, were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Hickson and in view of Klein.⁶ The independent claims have now been amended and the Applicants submit that the cited references fail to teach or suggest all the limitations of the claims as now presented.

As reflected in the claims, the present invention relates to methods and computer program products for the protected serial access to associated messages. The claims provide that, *inter alia*, messages are stored and determined to belong to a conversation group. The conversation group is identified by a unique group identifier. The conversation group is locked via the group identifier. Exclusive serial access is provided to the messages of the conversation group and the messages of the group are processed in order. Another requestor is prevented from accessing the messages of the conversation group (by virtue of the lock). When a new message arrives, it is dynamically associated with the conversation group such that the new message inherits the lock and the another requestor is also prevented from accessing the new message.

Hickson discusses access to related groups of data items and marking and locking a group and preventing access to items except on provision of an unlocking key.⁷ Klein discusses

users should be treated no differently for purposes of patent eligibility than a computer disc such a CD or floppy disk. On a strictly factual basis it is highly questionable whether a signal or carrier wave is "transitory" or not otherwise "tangible." Simply because one cannot see or touch the medium does not change the reality that such a medium nonetheless is real and is used every day to transmit and download software just as effectively as software contained on a CD. Thus, to deny patent eligibility for such claims is to ignore the reality that such media is most certainly employed in the using and selling of software carried by such a medium, and thus denies claims to a patent owner that would otherwise provide a basis for asserting direct infringement against competitors, thereby relegating such subject matter to assertions of indirect infringement only, with no sound policy basis for doing so. To deny such computer program products of patent protection on this basis appears to be exalting form over substance. Moreover, asserted reason for treating so-called "signal" claims differently from other kinds of computer readable media (e.g., that wireless signals are transitory or not otherwise sufficiently tangible) is equally as true for other media such as disks or CDs. Executable instructions on a disk or CD, like those carried by a signal, also cannot be understood or executed until those computer-executable instructions are off-loaded from the disk or CD into the computer's RAM. In that sense a disk or CD is no less "transitory" than a carrier signal, and hence the asserted factual distinction as to a signal's being "transitory" simply lacks merit

⁶ Office Comm. p. 4.

⁷ See Hickson, Abstract.

methods to facilitate routing messages in a communication framework.⁸ The cited references fail, however, to teach or suggest all the limitations of the claims as now presented.

In particular, the cited references fail to teach or suggest determining from information associated with the one or more messages that each of the one or more messages belongs to a conversation group, the conversation group comprising a conversation group topology which comprises a plurality of dialogs, each dialog comprising a plurality of the one or more messages. The cited references also fail to teach or suggest tracking the conversation corresponding to the conversation group. The cited references also fail to teach or suggest upon a new message arriving, dynamically associating the new message with the locked conversation group such that the new message inherits the lock and the disparate requestor is prevented from accessing the new message.⁹

Independent claim 29 recites a computer program product embodiment of the method of claim 17. Independent claim 22 recites a method similar to that of claim 17 but recited from the perspective of receiving a request (as compared to requesting a message). Accordingly, the discussion above applies to each of independent claims 17, 22, and 29.

Because of at least the distinctions noted, *inter alia*, the Applicants submit that rejections of independent claims 17, 22, and 29 under 35 U.S.C. § 103(a) as being unpatentable in view of Hickson and in view of Klein would be improper and should be withdrawn. Accordingly, the Applicants respectfully request favorable reconsideration of each of independent claims 17, 22, and 29 as now presented (as well as the respective dependent claims).

In view of the foregoing, Applicant respectfully submits that other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any

⁸ See Klein, Abstract.

⁹ As noted in the interview, no considered prior art reference teaches or suggests a new message arriving and inheriting the lock of the associated group. Further, as noted in the interview, such a limitation would place the independent claims in condition for allowance.

Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; and/or (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 533-9800.

Dated this 17th day of June, 2011.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", with a stylized flourish at the end.

RICK D. NYDEGGER
Registration No. 28,651
THOMAS M. BONACCI
Registration No. 63,368
Attorneys for Applicant
Customer No. 47973

RDN:TMB:crb
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